

Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/533,953

Applicant(s)

KAWATO ET AL.

Examiner

Sanza L. McClendon

Art Unit

1796

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 January 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-3 and 5-18.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Sanza L. McClendon/
Primary Examiner
Art Unit: 1796

Continuation of 11, does NOT place the application in condition for allowance because: Applicant argues that Takagi et al is not prior art since the instant application claims priority to JP2002-329533 filed Nov. 13, 2002 and the reference is the US national stage of PCT/JP02/12177 filed 11/21/2002 and published as WO2003/044090. However applicant has not perfected the filing date of 11/13/2002 without the filing of a certified English language translation of the priority document JP2002-329533. Additionally applicant argues the reference Takagi et al (6,956,073) does not set forth in the instant invention b/c the method of treating the TiO₂ particles are different then the treated particles of the instant invention. Applicant points the examiner to column 22, line 56 to column 23, line 9 as proof that Takagi et al washes said particles prior to surface coating and as a result of the taught method in the reference said coating particles "may contain" substantially greater amounts of metal cations in comparison with the instantly claimed invention. this is not convincing since in the quoted passage of the reference to titanium particles are first added to an aqueous slurry (1), wet-pulverized and collected (2-3), then adding said aluminum salt to said collected particles and neutralizing to coat said Titanium particles (4 and 5), then in step 6 said coated particle slurry is treated to remove by-products and adjusting the pH of said coated slurry and filtering said coated slurry and then subsequently "washing the obtained filtered coated slurry in pure water". Steps 7 and 8 include drying the washed cake and milling the cake. It appears the coated slurry in step 6 is washed in pure water what is not clear is if the washed slurry has been washed such that the alkali metal cations and the alkaline-earth metal cations can be extracted to a total amount of 120 mass ppm or lower. Since the PTO is not equipped to conduct experimentation in order to determine whether applicant's composition and/or particles differ and, if so, to what extent, from the reference, thus, with the showing of the reference, the burden of establishing non-obviousness by objective evidence has been shifted to Applicant as stated in the previous rejection.